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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,013	12/10/2003	Fong-Shi Lin	MR1197-597	5216
4586	7590	09/07/2005		
ROSENBERG, KLEIN & LEE 3458 ELLICOTT CENTER DRIVE-SUITE 101 ELLICOTT CITY, MD 21043			EXAMINER NEGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,013

Applicant(s)

LIN, FONG-SHI

Examiner

Ismael Negron

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Abstract

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

1. The abstract of the disclosure is objected to because uses phrases which can be implied. Correction is required. See MPEP § 608.01(b).
2. The Examiner respectfully suggests amending the abstract to read:

~~The invention relates to a~~ **A** ~~rotatable lighting decoration, which~~
includes a ~~supporting frame to connect with~~ **for supporting** a motor
~~having a link for connecting with~~ **attached by a link to** a patterned

decoration with light string. The motor is electrically connected to a power source by a conductive pin/ring structure can rotate the decoration and the string at the same time to obtain a rotary lighting decoration.

Double Patenting

Non-Statutory

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over patented Claim 1 of U.S. Patent No. 6,494,595 (LIN).

4. LIN teaches rotary patterned lamp having:

- **a supporting frame**, patented Claim 1, line 2;
- **two conductive pins**, patented Claim 1, line 13;
- **one of the conductive pins being connected to a positive pole of a power source**, patented Claim 1, lines 15-22;
- **the other of the conductive pins being connected to a negative pole of a power source**, patented Claim 1, lines 15-22;
- **a joint**, patented Claim 1, line 3;
- **a conductive rod**, patented Claim 1, line 4;
- **the conductive rod being part of a motor**, patented Claim 1, lines 5-7;
- **the joint being for holding the conductive rod**, patented Claim 1, line 4;
- **a conductive ring**, patented Claim 1, line 8;
- **the ring being positioned around the body of the motor**, patented Claim 1, lines 8 and 9;
- **one conductive pin contacting the conductive rod**, patented Claim 1, lines 18-20;

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- **the other conductive pin contacting the conductive ring,**
patented Claim 1, line 18-21;
- **a patterned decoration,** patented Claim 1, line 23;
- **a link,** patented Claim 1, line 10;
- **the link being mounted under the motor,** patented Claim 1, lines
10-12;
- **the decoration being connected to the link,** patented Claim 1,
lines 23 and 24;
- **a light string,** patented Claim 1, line 25;
- **the light string being hung on the decoration,** patented Claim 1,
lines 25 and 26; and
- **the string being electrically connected to the conductive rod
and ring,** patented Claim 1, lines 25-32.

5. LIN teaches all the limitations of the claims, except:

- the frame having with two downward connecting slices for
supporting the conductive pins; and
- the joint having an inner bearing.

6. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made that the patented conductive pins of LIN required a support structure attaching the pins to the frame. In addition, it would have

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been obvious to one of ordinary skill in the art at the time the claimed invention was made to add an inner bearing to the patented fixed receiver/joint of LIN to reduce the rotational friction between such fixed receiver and the rotator conductive rod. The Examiner further takes Official Notice that the use of bearings for increasing the efficiency of rotatable structure by reducing the rotational friction between relatively rotatable members is old and well known in the art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over CRISTIAN et al. (U.S. Pat. 4,734,830).

8. CRISTIAN et al. discloses an illumination device having:

- **a supporting frame**, Figure 1, reference number 18;
- **the frame having with two downward connecting slices**, column 6, lines 50-55;

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- **two conductive pins**, Figure 2, reference numbers 84 and 85;
- **the pins being mounted respectively on the two connecting slices**, column 6, lines 50-55;
- **one of the conductive pins being connected to a positive pole of a power source**, column 7, lines 14-22;
- **the other of the conductive pins being connected to a negative pole of a power source**, column 7, lines 14-22;
- **a joint**, Figure 1, reference number 43;
- **the joint having an inner bearing**, Figure 2, reference number 58;
- **the inner bearing being provided under the frame**, as seen in Figure 2;
- **a conductive rod**, Figure 1, reference number 64;
- **the joint being for holding the conductive rod**, as seen in Figure 2
- **a conductive ring**, Figure 2, reference number 65;
- **one conductive pin contacting the conductive rod**, as seen in Figure 2;
- **the other conductive pin contacting the conductive ring**, as seen in Figure 2;
- **a patterned decoration**, Figure 1, reference number 26;
- **a link**, Figure 1, reference number 28;
- **a motor**, Figure 1, reference number 40

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- **the link being mounted under the motor**, as seen in Figure 1;
- **the decoration being connected to the link**, as seen in Figure 1;
- **a light string**, Figure 1, reference numbers 36A and 36B;
- **the light string being hung on the decoration**, as seen in Figure 1;
- **the string being electrically connected to the conductive rod and ring**, inherent.

CRISTIAN et al. discloses all the limitation of the claims, except the conductive rod being part of a motor, or the ring being positioned around the body of the motor. It is noted that the claimed language define the invention as not including the motor structure, but merely recite the joint as being for holding such motor structure (emphasis added). The applicant is advised that it has been held by the courts that the recitation that an element is adapted to perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138.

9. However, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to have the conductive rod of CRISTIAN et al. as part of the motor, or the ring being positioned around the body of the motor, since the applicant has not disclosed that the conductive rod being part of the motor, or having the ring around the motor solves any problem or is for a particular reason. It appears that the claimed invention would perform equally well with the structure as disclosed.

Relevant Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bradshaw (U.S. Pat. 796,559), **Rowe** (U.S. Pat. 872,200), **Siegel** (U.S. Pat. 1,039,828), **Tacy** (U.S. Pat. 2,857,788) and **Fu** (U.S. Pat. 4,996,633) disclose a plurality of illumination devices having a motor, a decoration and a light string. The motor rotates the decoration and the light string at the same time.

Conclusion

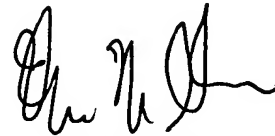
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

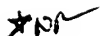
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



THOMAS M. SEMBER
PRIMARY EXAMINER


Inr

September 3, 2005